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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,745	06/29/2000	Stephen C. Tulley	00-018	7481
22927	7590	02/10/2004		
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			EXAMINER CAPRON, AARON J	
			ART UNIT 3714	PAPER NUMBER 14
DATE MAILED: 02/10/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/606,745

Applicant(s)

TULLEY ET AL.

Examiner

Aaron J. Capron

Art Unit

3714

*JA*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 and 54-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35 is/are allowed.
- 6) ☒ Claim(s) 1-26, 28-34, 36-46 and 54-56 is/are rejected.
- 7) ☒ Claim(s) 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

### DETAILED ACTION

This is a response to the Amendment received on November 24, 2003, in which claims 54-56 were added. Claims 1-46 and 54-56 are pending.

#### *Priority*

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Regarding 35 U.S.C. § 120, in order for the present application to claim the benefit of the filing date of another nonprovisional application, the nonprovisional application must be, copending, filed prior to the present application and inventor overlap. Applicant cannot claim the priority to 5,871,398 since 10/620,260 is not a prior document, see 37 C.F.R. 1.78(a). Hence, the amendment to the priority of the present application fails to meet the priority requirement of 35 U.S.C. § 120. Please update the amended specification to delete the portion claiming priority and the resulting changes to the related applications and patents (Paper #13, pages 10-11).

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 6, 8-9, 11, 33-34 and 43-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Schneier et al. (U.S. Patent No. 5,871,398; hereafter “Schneier”).

Referring to claims 1 and 33, Schneier discloses determining an outcome amount associated with a total number of events (a player buys a plurality of lottery tickets and wins with one or more tickets) and based on a parameter specified by a player (number of tickets bought), allocating the total amount based upon the total number of tickets bought.

Referring to claims 6, 8-9 and 11, the players receive an indication that the player has bought the tickets and it is performed over a communication network.

Referring to claim 34, Schneier discloses a player providing a payment to play the lottery game tickets, the computer determining the total winnings, based on the number of tickets bought by the player, each ticket having their own win value, revealing to the player the total amount won for each ticket and arranging for the player to receive a payment associated with the winning amount.

Claims 43-44 correspond in scope to a method set forth for use of the method listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 1-2, 5-12, 15-19, 25-26, 28-30, 36-40 and 43-46 are rejected under 35 U.S.C. 102(b) as anticipated by Richardson (U.S. Patent No. 5,042,809).

Referring to claims 1-2, 25-26, and 28-30, Richardson discloses a casino determining an outcome amount (total prize winnings from a lottery game) of a computerized lottery game with a total number of events (total number of distributed lottery tickets), based on the number of tickets that all players select, allocating the total prize winnings amongst the total number of tickets.

Referring to claims 5-8, Richardson discloses retrieving and receiving an indication on the number of games played by the player (18:60-19:27) at a player device over a network.

Referring to claims 9-12 and 14, the lottery agency determines the total prize winnings for a lottery event either at a controller or an event result server over a network (18:60-19:27).

Referring to claims 15-16, the awards are distributed through the player devices, wherein the player device is a computerized device.

Referring to claims 17-18, allocating includes selecting a subset of total number of events and allocating the outcome amount among the subset of total number of events (19:1-10), wherein each ticket has a winning or losing outcome that has been redeemed or not.

Referring to claim 19, the total winnings is allocated by a random number generator (6:60-63).

Claims 36-40 and 43-46 correspond in scope to a game apparatus, medium and method set forth for use of the gaming method listed in the claims above and are encompassed by use as set forth in the rejection above.

Referring to claim 56, the distribution is the same over a period of time and the standard deviation would be zero.

Claims 1-26, 28-32, 36-43, 46 and 54-56 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Walker et al. (U.S. Patent No. 6,068,552; hereafter "Walker").

Referring to claims 1-3, Walker discloses a gaming device wherein a gaming machine determines the payout (10:22-31) associated with a total number of events (payout dependent upon player selection); and based on the parameter chosen by the player, allocating the payout amongst a total number of events (such as a payout date), wherein the payout is greater than one. Walker discloses saving the parameter of the determination of a number of payouts by stating that same steps in the diagram could be used to implement the player customization of the payout portions over a period of time (10:18-31).

Referring to claims 20, a player can alter the parameters at any time and can win multiple jackpots, thus having the option to set up different payouts for different period of time (for example 100,000 spread out over 10 years and 500,000 spread over 20 years), which allows a player to re-allocate the outcome of amount among two separate total number of events.

Referring to claim 56, the distribution is the same over a period of time and the standard deviation would be zero.

***Allowable Subject Matter***

Claim 35 is allowed.

While the prior art reference of record provides a player wagering an amount in a lottery game, wherein the player allocates the outcome amount amongst a plurality of events. However, the prior art fails to teach, disclose or suggest re-allocating the outcome amount among a modified number of lottery tickets, as claimed in Applicants' invention.

Claim 27 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Response to Arguments*

Applicant's arguments with respect to claims 1-7, 9-10, 12-30, 36-39, 41-43 and 45-46 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments, see pages 12-15, filed November 24, 2003, with respect to the rejection(s) of claim(s) 1-7, 9-10, 12-30, 36-39, 41-43 and 45-46 under *Manship* have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of anticipation of Walker and anticipation of Richardson.

Applicant argued that *Schneier* no longer qualifies as prior art. However, as shown above, the Applicant cannot claim the priority to 5,871,398 since 10/620,260 is not a prior document, see 37 C.F.R. 1.78(a). Therefore, the claimed invention fails to preclude the lottery game of *Schneier*. Proper claim in priority to 5871398 not established.

*mal*


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ajc



MARK SAGER  
PRIMARY EXAMINER